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Louis Vuitton Malletier v Renown Incorporated

B HIGH COURT (KUALA LUMPUR) — ORIGINATING SUMMONS NO 24IP-16–09 OF 2016
WONG KIAN KHEONG JC
21 MARCH 2017

C *Civil Procedure — Originating summons — Service of originating process out of jurisdiction — Plaintiff applied to expunge defendant's registered trademark from register under s 46(1)(b) of the Trade Marks Act 1976 ('the Act') — Whether by reason of s 79 of the Act read with reg 10 of the Trade Marks Regulations 1997, originating summons may be lawfully served by plaintiff only on defendant's address with registrar*

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Trade Marks — Application to expunge from register — Registered mark — Plaintiff vide originating summons ('OS') applied to expunge defendant's registered trademark from register under s 46(1)(b) of the Trade Marks Act 1976 ('the Act') — Whether by reason of s 79 of the Act read with reg 10 of the Trade Marks Regulations 1997, OS may be lawfully served by plaintiff only on defendant's address with registrar — Patents Regulations 1986 reg 51(1) & (2) — Rules of Court 2012 O 1 r 2(2) & O 11 r 9(1) — Trade Marks Act 1976 ss 46(1)(b), 79(1) & (5) — Trade Marks Regulations 1997 reg 10(1) & (5)

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In the present originating summons ('the OS'), the plaintiff applied to expunge the defendant's registered trademark from the register under s 46(1)(b) of the Trade Marks Act 1976 ('the Act') on the ground that the defendant had not used the defendant's registered trademark in good faith. It must be noted that the defendant was incorporated in Japan and had no office in Malaysia. Nonetheless, the defendant had an address of service at Drewmarks Patents & Designs (M) Sdn Bhd, 9th floor, Bangunan Getah Asli, 148, Jalan Ampang, 50450, Kuala Lumpur as registered with the registrar ('the defendant's address with registrar'). Initially the OS was served on the defendant's address with registrar but subsequently, pursuant to O 11 r 9(1) of the Rules of Court 2012 ('the RC'), the plaintiff obtained leave of court to serve the OS out of jurisdiction on the Japanese address. The sole issue for consideration was whether by reason of s 79 of the Act read with reg 10 of the Trade Marks Regulations 1997 ('the TMR'), the OS may be lawfully served by the plaintiff only on the defendant's address with the registrar.

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Held, allowing the OS with no order as to costs:

(1) The court allowed the OS because upon the service of the OS on the Japanese address, the defendant wrote a letter dated 19 January 2017 which stated that the defendant had not used the defendant's registered trademark in Malaysia and had no intention to oppose the OS (see para 10).

(2) Section 79(1) and (5) of the Act, the first limb of reg 10(1) of the TMR, and reg 10(5) of the TMR ('the four provisions') have expressly provided for service of any 'written communication' 'for all purposes' on the foreign applicant's address for service in the register. Accordingly, in view of the wording in the four provisions, O 11 r 9(1) of the RC cannot apply by virtue of O 1 r 2(2) of the RC. Nevertheless, a prudent plaintiff may still resort to O 11 r 9(1) of the RC and apply for leave of court to serve the OS out of the jurisdiction of Malaysia court. In addition, the court was of the view that reg 51(1) and (2) of the Patents Regulations 1986 should be interpreted along the lines of the four provisions (see paras 19, 21 & 23).

[Bahasa Malaysia summary

Dalam saman pemula ini ('SP'), plaintif memohon untuk membatalkan cap dagangan berdaftar daripada daftar di bawah s 46(1)(b) Akta Cap Dagangan 1976 ('Akta') atas alasan bahawa defendan tidak menggunakan cap dagangan berdaftar defendan secara suci hati. Ia mesti diambil kira bahawa defendan ditubuhkan di Jepun dan tidak mempunyai pejabat di Malaysia. Walau bagaimanapun, defendan mempunyai alamat perkhidmatan di Drewmarks Patents & Designs (M) Sdn Bhd, 9th Floor, Bangunan Getah Asli, 148, Jalan Ampang, 50450, Kuala Lumpur seperti didaftarkan dengan pendaftar ('alamat defendan dengan pendaftar'). Pada mulanya SP diserahkan kepada alamat defendan dengan pendaftar tetapi kemudiannya, berikutan A 11 k 9(1) Kaedah-Kaedah Mahkamah 2012 ('KKM'), plaintif memperolehi izin daripada mahkamah untuk menyerahkan SP di luar bidang kuasa kepada alamat Jepun. Satu-satunya isu untuk pertimbangan adalah sama ada atas alasan s 79 Akta dibaca bersama dengan peraturaan 10 Peraturan-Peraturan Cap Dagangan 1997 ('PCD'), SP boleh secara sah diserahkan oleh plaintif hanya kepada alamat defendan dengan pendaftar.

Diputuskan, membenarkan SP tanpa perintah terhadap kos:

(1) Mahkamah membenarkan SP kerana atas penyerahan SP kepada alamat Jepun, defendan menulis surat bertarikh 19 Januari 2017 yang menyatakan bahawa defendan tidak menggunakan cap dagangan berdaftar defendan di Malaysia dan tidak mempunyai niat untuk menentang SP tersebut (lihat perenggan 10).

(2) Seksyen 79(1) dan (5) Akta, bahagian pertama peraturan 10(1) PCD, dan peraturan 10(5) PCD ('keempat-empat peruntukan') telah secara

nyata memperuntukkan penyerahan apa-apa 'written communication' 'for all purposes' kepada alamat pemohon asing bagi penyerahan dalam daftar. Oleh itu, mengambil kira perkataan di dalam keempat-empat peruntukan, A 11 k 9(1) KKM tidak boleh digunapakai mengikut A 1 k 2(2) KKM. Walau bagaimanapun, plaintif yang berhati-hati boleh merujuk kepada A 11 k 9(1) KKM ada memohon untuk izin daripada mahkamah bagi menyerahkan SP di luar bidang kuasa mahkamah Malaysia. Selanjutnya, mahkamah adalah berpendapat bahawa peraturan 51(1) dan (2) Peraturan-Peraturan Paten 1986 patut ditafsirkan mengikut keempat-empat peruntukan tersebut (lihat perenggan 19, 21 & 23).]

Notes

For a case on service of originating process out of jurisdiction, see 2(1) *Mallal's Digest* (5th Ed, 2017 Reissue) para 6803.

For cases on registered mark, see 12(2) *Mallal's Digest* (5th Ed, 2015) paras 2603–2604.

Cases referred to

Johnson & Johnson's Application [1991] RPC 1, HC (refd)

Kraft Foods Schweiz Holding GmbH v Pendaftar Cap Dagangan [2016] 11 MLJ 702, HC (refd)

Lai Kim Loi v Dato' Lai Fook Kim & Anor [1989] 2 MLJ 290; [1989] 1 CLJ Rep 61, SC (refd)

PP v Yap Min Woie [1996] 1 MLJ 169, FC (refd)

Legislation referred to

Companies Act 1965 s 218

Companies (Winding Up) Rules 1972

Federal Constitution art 160(2)

Interpretation Acts 1948 and 1967 s 3

Patents Regulations 1986 reg 51, 51(1), (2)

Rules of Court 2012 O 1 r 2(2), O 11 r 9, 9(1), O 62 r 4, 4(1), (2)

Rules of the High Court 1980

Trade Marks Act 1976 ss 46(1)(b), 79, 79(1), (3), (4), (5)

Trade Marks Regulations 1997 regs 4, 9, 10, 10(1), (5), Second Schedule, Form TM 1

Trade Marks Rules [SG] r 11(8)

Trade Marks Rules 1986 [UK] r 13, 13(5)

Trade Marks Rules 2008 [UK] rr 11, 12

Chew Kherk Ying (Woo Wai Teng and Yeoh Yao Huang with her) (Wong & Partners) for the plaintiff.

Absent for the defendant.

Wong Kian Kheong JC:

INTRODUCTION

[1] The plaintiff company ('the plaintiff') is an international fashion house renowned for its high-end fashion goods under the brand 'Louis Vuitton'.

[2] The defendant company ('the defendant') is incorporated in Japan and has no business or office in Malaysia.

[3] The defendant had applied to the Registrar of Trademarks ('the registrar') to register a combination mark 'ZEPHYR' ('ZEPHYR mark') for goods in Class No 25 ('the defendant's application'). In the defendant's application, the defendant had given to the registrar the following addresses:

(a) the defendant's address in Japan, 8–8–20, Nishi-Gotanda, Shinagawa-ku, Tokyo, Japan ('Japanese address'); and

(b) an address of service at Drewmarks Patents & Designs (M) Sdn Bhd, 9th floor, Bangunan Getah Asli, 148, Jalan Ampang, 50450 Kuala Lumpur ('the defendant's address with registrar').

[4] The registrar had allowed the defendant's application and consequently, ZEPHYR mark with trademark registration No 95010243 had been registered in the defendant's favour in the Register of Trademarks ('the register') with effect from 28 September 1995 ('the defendant's registered trademark').

[5] In this OS, the plaintiff applies to court to expunge the defendant's registered trademark from the register under s 46(1)(b) of the Trade Marks Act 1976 on the ground that the defendant has not used the defendant's registered trademark in good faith. Initially, the OS was only served on the defendant's address with registrar.

SOLE ISSUE

[6] The only question raised in this case is whether by reason of s 79 of the Trade Marks Act 1976 ('the TMA') read with reg 10 of the Trade Marks Regulations 1997 ('the TMR'), the OS may be lawfully served by the plaintiff only on the defendant's address with registrar. If the answer to this issue is 'yes', the plaintiff need not apply for leave of this court to serve the OS on the defendant out of jurisdiction of Malaysian courts as required by O 11 r 9(1) of the Rules of Court 2012 ('the RC').

A RELEVANT PROVISIONS

[7] Section 79 of the TMA, regs 4, 9 and 10 of the TMR, O 1 r 2(2), O 11 r 9 and O 62 r 4 of the RC are reproduced below:

B 79 *Address for service*

(1) *Where an applicant for the registration of a trade mark does not reside or carry on business in Malaysia, he shall give to the Registrar an address for service in Malaysia which shall be the address of his agent, and if he fails to do so, the Registrar may refuse to proceed with the application.*

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(2) An address for service stated in the application or a notice of opposition shall, for the purposes of the application or notice of opposition, be deemed to be the address of the applicant or opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at, or sending them by post to, the address for service of the applicant or opponent, as the case may be.

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(3) An address for service may be changed by notice in writing to the Registrar.

(4) Subject to subsection (1), the registered proprietor of a trade mark shall from time to time notify the Registrar in writing of any change in the Register and the Registrar shall alter the Register accordingly.

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(5) *The address of the registered proprietor of a trade mark as appearing for the time being in the Register shall for all purposes under this Act be deemed to be the address of the registered proprietor.*

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reg 4 *Forms*

(1) The forms referred to in these Regulations are those contained in the Second Schedule.

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(2) *The forms shall be used in all cases in which they are applicable.*

reg 9 *Address*

Where any person is, by the Act or these Regulations, bound to furnish the Registrar with an address, the address given shall in all cases be as full as possible for the purpose of enabling the place of trade or business of such person to be found easily.

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reg 10 *Address for service*

(1) *An applicant, opponent, registered proprietor or registered user of a trade mark who does not reside or carry on business in Malaysia shall file Form TM1 giving an address for service in Malaysia and such address may be treated as the actual address of the person for all purposes connected with the matter in question.*

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(2) Any other applicant, opponent, registered proprietor or registered user of a trade mark may, if he so desires; file Form TM 1 giving an address for service in Malaysia.

(3) Subject to regulation 7, Form TM 1 filed under these Regulations may be signed by an authorised agent and in any case in which the Registrar so requires shall be signed by the applicant, opponent, registered proprietor or registered user, as the case may be.

(4) In any case in which no address for service is filed at the Office, the Registrar may treat the business address in Malaysia, if any, of the person concerned as his address for service for all purposes connected with the matter in question.

(5) *Any written communication addressed to a person at an address given by him or treated by the Registrar as his address for service shall be deemed to be properly addressed*.

(6) The Registrar may, at any time that a doubt arises as to the continued availability of an address for service entered in the Register, request the person for whom it is entered, by letter addressed to his business address in the Register, to confirm the address for service or to provide another by filing Form TM 1, and if within two months of making such a request the Registrar receives no confirmation or substitution of that address, he may strike the address off the Register.

O 1 r 2 Application

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r 2(2) *These Rules do not have effect in relation to proceedings in respect of which rules have been or may be made under any written law for the specific purpose of such proceedings* or in relation to any criminal proceedings.

...

O 11 r 9 *Service of originating summons*

(1) *Subject to paragraph (2), service out of the jurisdiction of an originating summons is permissible with the leave of the Court*.

(2) Where any proceedings begun by an originating summons might have been begun by writ, service out of the jurisdiction of the originating summons is permissible as aforesaid only if service of the notice of the writ out of the jurisdiction would be permissible had the proceedings been begun by writ.

...

O 62 r 4 *Service on corporation*

(1) *Where an action is against a corporation, the writ may be served —*

(a) by leaving a copy of it at the registered office (if any) of the corporation;

(b) by sending a copy of it by registered post addressed to the corporation at the office, or, if there are more offices than one at the principal office of the corporation, whether such office is situated within Malaysia or elsewhere;

(c) by handing a copy of it to the secretary or to any director or other officer of the corporation; or

(d) in the case of a foreign company registered under Part XI of the Companies Act 1965 by handing a copy of it to, or sending the same by registered post to, a person authorized to accept service of process on behalf of the foreign company.

(2) *The rule does not restrict the operation of the provisions of any written law as to service on any particular person or authority*.

... (Emphasis added.)

THE PLAINTIFF'S CONTENTIONS

[8] Ms Chew Kherk Ying, the plaintiff's learned counsel, submitted as follows:

(a) the present s 79(1) of the TMA has been introduced by Trade Marks (Amendment) Act 1994 (Act A881). According to s 79(1) of the TMA, if an applicant to register a trademark is a foreign person without an address in Malaysia ('foreign applicant'), the registrar may refuse to register the foreign applicant's trademark if the foreign applicant does not provide 'an address for service in Malaysia which shall be the address' of the foreign applicant's trademark agent. Such a statutory interpretation is fortified by reg 10(1) and (5) of the TMR;

(b) s 79(3) and (4) of the TMA provide the burden on a foreign applicant to update its address for service in Malaysia. The words 'Subject to subsection (1)' in s 79(4) of the TMA means that a foreign applicant is still required to give an address for service in Malaysia (which shall be the address of the foreign applicant's trademark agent);

(c) paras 2.56 and 21.10 of the *Manual of trademarks Law & Practice in Malaysia* (Manual) published by the Malaysian Intellectual Property Corp, support the above construction of s 79 of the TMA and reg 10 of the TMR;

(d) O 62 r 4(2) of the RC provides that 'does not restrict the operation of the provisions of any written law as to service on any particular person or authority'. The term 'person' is defined widely in s 3 of the Interpretation Acts 1948 and 1967 to include 'a body of persons, corporate or unincorporated'; and

(e) as there is no Malaysian case on the above statutory construction, Ms Chew relied on Mummery J's (as he then was) judgment in the English High Court case of *Johnson & Johnson's Application* [1991] RPC 1. In *Johnson*'s case:

(i) the appellant company had unsuccessfully opposed before the

registrar the application to register a trademark by the respondent company ('the registrar's decision');

(ii) the appellant company had appealed to the High Court against the registrar's decision by way of a notice of originating motion ('OM');

(iii) the respondent company is an American company which does not reside or carry on business in the United Kingdom ('UK');

(iv) the appellant company's solicitors served the OM on the respondent company's trademark agent in UK. The respondent company raised, among others, a procedural objection that the service of the OM on the respondent company's trademark agent in UK, was defective; and

(v) the above procedural objection was dismissed on the ground that r 13 of UK's then Trade Marks Rules 1986 ('the TMR 1986 (UK)') allowed the OM to be served on the respondent company's trademark agent in UK.

INITIAL DECISION

[9] When the OS was first heard, I formed the view that the plaintiff could not circumvent O 11 r 9(1) of the RC by serving the OS on the defendant's address with registrar. Hence, I did not proceed to hear the OS despite the plaintiff's service of the OS on the defendant's address with registrar.

[10] The plaintiff subsequently applied for and obtained leave of court to serve the OS out of jurisdiction on the Japanese address. Upon the service of the OS on the Japanese address, the defendant wrote a letter dated 19 January 2017 which stated that the defendant had not used the defendant's registered trade mark in Malaysia and had no intention to oppose this OS. Accordingly, this OS is allowed with no order as to costs.

CONSTRUCTION OF S 79 OF THE TMA AND REG 10 OF THE TMR

[11] After reconsidering this matter, except for the reliance on the manual and O 62 r 4(2) of the RC, I am of the view that Ms Chew is correct in the interpretation of s 79 of the TMA and reg 10 of the TMR.

[12] The manual does not constitute 'law' and cannot be resorted to in the construction of s 79 of the TMA and reg 10 of the TMR. It is decided in *Kraft Foods Schweiz Holding GmbH v Pendaftar Cap Dagangan* [2016] 11 MLJ 702, in para 27, as follows:

> *Firstly, the Construction Issue cannot be answered by reference to the registrar's Manual. This is because the registrar's Manual does not constitute 'law'*. Section 3 of the

Interpretation Acts 1948 and 1967 ('the IA') provides that the term 'law' has the meaning assigned by art 160(2) of the Federal Constitution ('the FC'). Article 160(2) of the FC provides:

> *'law' includes written law, the common law in so far as it is in operation in the Federation or any part thereof, and any custom or usage having the force of law in the Federation or any part thereof*; (Emphasis added.)

The term 'written law' is defined in s 3 of the IA to mean, among others, FC, State Constitutions, Acts of Parliament and subsidiary legislation made thereunder.

It is clear that the registrar's manual is not 'law' and 'written law' within the meaning of s 3 of the IA read with art 160(2) of the FC. In any event, para 1.3 of the registrar's manual states that the registrar's manual 'is intended primarily for the guidance and instruction of the staff of the Trade Marks Registry. (Emphasis added.)

[13] Order 62 r 4(1) of the RC applies to service of writs (not the service of OS) on corporations. As such, O 62 r 4(2) of the RC permits other modes of service of writ (not the service of OS) on corporations as provided by any other written law.

[14] Firstly, s 79(1) of the TMA provides that where a foreign applicant does not reside or carry on business in Malaysia, the foreign applicant 'shall give to the Registrar an address for service in Malaysia which shall be the address of his agent'. The use of the mandatory term 'shall' in s 79(1) of the TMA, in my view, means that the legislature has intended for this provision to be mandatory. In the Federal Court case of *Public Prosecutor v Yap Min Woie* [1996] 1 MLJ 169, at pp 172–173, Mohd Dzaiddin FCJ (as he then was) gave effect to the mandatory term 'shall'.

[15] Secondly, Parliament has provided in s 79(5) of the TMA that the defendant's address with registrar 'shall for all purposes under (TMA) be deemed to be the address of the registered proprietor'. Section 79(5) of the TMA:

(a) is a mandatory provision by reason of the use of the mandatory term 'shall'; and

(b) has effect 'for all purposes' under the TMA, including an application to expunge a registered trademark under s 46(1)(b) of the TMA (such as this OS).

[16] Regulation 10(1) of the TMR has the following two limbs:

(a) according to the first limb of reg 10(1) of the TMR:

(i) a foreign applicant 'shall file Form TM 1 giving an address for service in Malaysia'. The use of the imperative term 'shall' in reg

10(1) of the TMR clearly means that this provision is mandatory; and

(ii) box No 7 of Form TM 1 in the Second Schedule to TMR ('Form TM 1') states that 'I request that all communication concerning the above trademark be sent to the address indicated, which is the address for service'. When a foreign applicant fills up Form TM 1, this means that the foreign applicant expressly requests that 'all communication' concerning the foreign applicant's trademark be sent to the address for service as stated in Form TM 1. The foreign applicant cannot subsequently insist on another mode of service regarding 'all communication' regarding the foreign applicant's trademark. It is to be noted that according to reg 4(2) of the TMR, all forms in the Second Schedule to the TMR, including Form TM 1, 'shall be used in all cases in which they are applicable'; and

(b) the second limb of reg 10(1) of the TMR provides that the foreign applicant's address for service in the register 'may be treated as the actual address' of the foreign applicant 'for all purposes connected with the matter in question'.

[17] Regulation 10(5) of the TMR provides that any 'written communication addressed' to the foreign applicant's 'address for service shall be deemed to be properly addressed'. Regulation 10(5) of the TMR has the following effect:

(a) reg 10(5) of the TMR is a mandatory provision by reason of the employment of the mandatory term 'shall'; and

(b) reg 10(5) of the TMR deems any 'written communication addressed' to the foreign applicant's 'address for service' 'to be properly addressed'. Regulation 10(5) of the TMR is similar to r 13(5) of the TMR 1986 (UK) which reads as follows:

> *Anything sent to any person at an address filed by him as his address for service shall be deemed to be properly sent.* (Emphasis added.)

Johnson's case was based on r 13(5) of the TMR 1986 (UK). In view of the similarity between r 13(5) of the TMR 1986 (UK) and our reg 10(5) of the TMR, I am of the view that *Johnson*'s case may be resorted to in the construction of reg 10(5) of the TMR. As such, reg 10(5) of the TMR deems any service of document on the foreign applicant's address for service in the register to be 'properly addressed'.

It is to be noted that r 13(5) of the TMR 1986 (UK) is now replaced by rr 11 and 12 of the Trade Marks Rules 2008 (UK). Rule 11(8) of the Singapore's Trade Marks Rules, GN No S 635/1998, provides as follows:

> Anything sent to or served on a person at his address for service shall be taken

to have been duly sent to or served on the person. (Emphasis added.)

[18] Regulation 9 of the TMR provides that where any person is bound to furnish to the registrar with an address (in this case, bound by s 79(1), (4) of the TMA and reg 10(1) of the TMR), 'the address given shall in all cases be as full as possible for the purpose of enabling the place of trade or business of such person to be found easily'.

[19] As explained above:

(a) s 79(1) of the TMA;

(b) s 79(5) of the TMA;

(c) the first limb of reg 10(1) of the TMR; and

(d) reg 10(5) of the TMR,

(*Four Provisions*)

have expressly provided for service of any 'written communication' 'for all purposes' on the foreign applicant's address for service in the register. Accordingly, in view of the wording in the four provisions, O 11 r 9(1) of the RC cannot apply by virtue of O 1 r 2(2) of the RC. In the Supreme Court case of *Lai Kim Loi v Dato' Lai Fook Kim & Anor* [1989] 2 MLJ 290 at pp 294–295; [1989] 1 CLJ Rep 61, at pp 69–70, Gunn Chit Tuan SCJ (as he then was) did not apply the then applicable Rules of the High Court 1980 in a petition under s 218 of the Companies Act 1965 but instead applied the specific Companies (Winding Up) Rules 1972.

[20] I acknowledge that the above interpretation of the four provisions may result in possible injustice against foreign owners of registered trademarks ('foreign owners') in the following circumstances:

(a) a plaintiff may only serve the originating process ('suit') on the foreign owner's address of service in the register;

(b) for various reasons, the foreign owner may not have actual notice of the suit; and

(c) the foreign owner may suffer the following possible injustice:

(i) judgment in default of appearance may be entered against the foreign owner; or

(ii) the suit may be heard and decided against the foreign owner in the absence of the foreign owner.

[21] Despite the above construction of the four provisions, a prudent plaintiff may still resort to O 11 r 9(1) of the RC and apply for leave of court

to serve the OS out of the jurisdiction of Malaysian court.

REGULATION 51 OF THE PATENTS REGULATIONS 1986 ('THE PR')

[22] Regulation 51(1) and (2) of the PR provide as follows:

reg 51 *Address for service.*

(1) *Every person concerned with any proceedings under the Act or any regulation made thereunder and every owner of a patent shall furnish to the Registrar, on Form 20 together with the payment of the prescribed fee, an address for service in Malaysia, which may be treated for all purposes concerning or connected with such proceedings or patent as the address of the person concerned.*

(2) *Notwithstanding sub-regulation (1), where a patent agent has been appointed, the address for service shall be the address of the patent agent.* (Emphasis added.)

[23] In closing, I must refer to reg 51(1) and (2) of the PR. I am of the view that in light of the wording of reg 51(1) and (2) of the PR, these two provisions should be interpreted along the lines of the four provisions.

OS allowed with no order as to costs.

Reported by Dzulqarnain Ab Fatar